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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/647,895

08/26/2003

John Blumenthal

4605-001

3576

22429

7590

11/10/2005

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EXAMINER

WRIGHT, ANDREW D

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/647,895

Applicant(s)

BLUMENTHAL ET AL.

Examiner

Andrew Wright

Art Unit

3617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 13 October 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 18, 19 and 30.

Claim(s) objected to: 22-29.

Claim(s) rejected: 15-17, 20, 21 and 31-34.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Andrew Wright
Primary Examiner
Art Unit: 3617

AW 11/8/05

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 10/28/05 have been fully considered but they are not persuasive.

Applicant first asserts that the examiner has ignored elements of the claim (Remarks of 10/28/05, page 7). This is not persuasive. It is described in paragraph 4 of the Final Rejection (5/13/05) how the outlet velocity is greater than the inlet velocity. It is described in paragraph 5 of the Final Rejection how this could possibly happen during the craft moving forward. Therefore, no elements have been ignored. Therefore, applicant's argument is not persuasive.

Applicant next argues that the Springston ('261) patent teaches that the apparatus can only be used on the floor of the body of water (Remarks, pages 7-8). This is inaccurate and not persuasive. Springston teaches that the apparatus can be used in either of two ways: (1) suspended vertically or at an angle at any desired depth below the surface, or (2) while resting on the bottom of the body of water (see Springston column 1, lines 64-68 and column 2, lines 29-33). Therefore, the apparatus can be suspended below the surface but not resting on the bottom. Therefore, the apparatus could theoretically be used while the boat is underway. For these reasons, applicant's argument is not persuasive.

Applicant next argues that the Springston device cannot be used while moving forward because shore power is required to operate it (Remarks, page 8). This is not persuasive. Applicant is making a mere assertion that is unsupported by any evidence. Furthermore, applicant is making an assumption of the type of power available on any given vessel. For these reasons applicant's argument is not persuasive.

Applicant next argues that the Springston apparatus must be used while the boat is not moving based upon a Declaration (Remarks, page 8). This is not persuasive. The argument states that the declarant has intimate knowledge of the Springston apparatus, and that he has never seen the Springston apparatus used while the boat is moving. Even if this is true, it does not overcome the rejection. Claim 15 recites an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here the Springston apparatus is capable of being used while a boat is moving forward. The fact that the declarant has never seen it happen doesn't make it impossible. Therefore, applicant's argument is not persuasive.